

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STEVEN C. KACINES

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Appeal No. 1999-1747  
Application No. 08/715,422<sup>1</sup>

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ON BRIEF

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Before CALVERT, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 16, which are all of the claims pending in this application.<sup>2</sup>

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<sup>1</sup> Application for patent filed September 18, 1996.

<sup>2</sup> We note that claim 6 was never included in any of the rejections under 35 U.S.C. § 103 set forth by the examiner in any Office action. However, the examiner did indicate in the disposition of claims section of the Office Action Summary that claim 6 was rejected. Therefore, for purposes of this appeal, we will considered claim 6 to be rejected on the same  
(continued...)

Appeal No. 1999-1747  
Application No. 08/715,422

We REVERSE and enter a new rejection pursuant to 37 CFR  
§ 1.196(b).

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<sup>2</sup>(...continued)  
basis as its parent claim (i.e., claim 5).

BACKGROUND

The appellant's invention relates to a quick connect coupling for connecting a brake hose to a brake tube in a hydraulic brake hose assembly. A copy of the claims under appeal appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Dick 1, 1936	2,062,449	Dec.
Eschbaugh 30, 1974	3,826,523	July
Legriss 1976	3,963,267	June 15,
Guest 1987	4,645,246	Feb. 24,
Tarum 1989	4,828,297	May 9,
Spors et al. 1991 (Spors)	5,064,227	Nov. 12,
Joseph et al. 1995 (Joseph)	5,387,016	Feb. 7,
Rea et al. 1996 (Rea)	5,573,279	Nov. 12,

(filed June 7, 1995)

Claims 1, 2 and 7 to 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eschbaugh in view of Joseph and Spors.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Eschbaugh in view of Joseph and Spors as applied to claim 2 above, and further in view of Tarum.

Claims 4 to 6<sup>3</sup> stand rejected under 35 U.S.C. § 103 as being unpatentable over Eschbaugh in view of Joseph, Spors and Tarum as applied to claim 3 above, and further in view of Rea.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Eschbaugh in view of Joseph and Spors as applied to claim 1 above, and further in view of Dick.

Claims 1 and 11 to 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Legris in view of Joseph and Guest.

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<sup>3</sup> Id.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Legris in view of Joseph and Guest as applied to claim 1 above, and further in view of Dick.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 6, mailed December 11, 1997) and the answer (Paper No. 14, mailed December 3, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 12, filed September 11, 1998) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant argues (brief, pp. 6-9) that the claims under appeal are directed to the combination of a brake hose, a brake tube and a quick connect coupling. The examiner has determined (final rejection, p. 3) that the claims under appeal are directed only to the quick connect coupling having the intended use of coupling a brake hose to a brake tube. Thus, before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood.<sup>4</sup> Accordingly, we will initially direct our attention to appellant's claim 1 (the only independent claim on appeal) to derive an understanding of the scope and content thereof.

However, before turning to the proper construction of claim 1, we believe it is important to review some basic principles of claim construction. First, and most important,

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<sup>4</sup> Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988).

the language of the claim defines the scope of the protected invention. Yale Lock Mfg. Co. v. Greenleaf, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); Autogiro Co. of Am. v. United States, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). See also Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 419 (1908); Cimiotti Unhairing Co. v. American Fur Ref. Co., 198 U.S. 399, 410 (1905).

Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984).

Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. See In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988). What we are dealing with in this case is the proper construction of the limitations recited in appealed claim 1.

Claim 1 reads as follows:

A quick connect coupling for connecting a brake hose to a brake tube in a hydraulic brake hose assembly, wherein the brake hose has an inside diameter in the range of about 1/8 inch to 3/16 inch, comprising:

a connector body having a first end for crimped connection to the brake hose and a second end for connection to the brake tube;

a resilient retaining element extending between the brake tube and connector body;

a stepped bore in the second end of the body for receiving the brake tube, the stepped bore including a



first bore section for communicating with the brake hose, a second bore section for receiving a sealing arrangement that seals between the brake tube and second bore section and a third bore section for receiving the retaining element;

a shoulder within the third bore section extending radially inwardly for engaging one portion [of] the retaining element to prevent axial movement of the retaining element out of the third bore section; and

a groove in the brake tube for abutting another portion of the retaining element to prevent axial movement of the tube from the connector body.

Our review of independent claim 1 reveals that we are unable to derive a proper understanding of the scope and content thereof. Specifically, for the reasons set forth below, we are unable to determine whether claim 1 is directed to the combination of a brake hose, a brake tube and a quick connect coupling as asserted by the appellant or that claim 1 is directed only to the quick connect coupling having the intended use<sup>5</sup> of coupling a brake hose to a brake tube.

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<sup>5</sup> The manner or method in which a machine (e.g., in this case, the quick connect coupling which attaches a brake hose to a brake tube) is to be utilized is not germane to the issue of patentability of the machine itself. See In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). A statement of intended use does not qualify or distinguish the structural apparatus claimed over the reference. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). There is an

(continued...)

The preamble of claim 1 (i.e., A quick connect coupling for connecting a brake hose to a brake tube in a hydraulic brake hose assembly, wherein the brake hose has an inside diameter in the range of about 1/8 inch to 3/16 inch) leads us in the direction that only the quick connect coupling is being claimed, that is, the brake hose and brake tube are not part of the claimed subject matter. We reach this conclusion based on the appellant's use of the phrase "for connecting" and the appellant's designation of the claimed subject matter as being "A quick connect coupling" rather than a brake hose assembly.

The first clause of claim 1 (i.e., a connector body having a first end for crimped connection to the brake hose and a second end for connection to the brake tube) leads us in

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<sup>5</sup>(...continued)  
extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. See generally Kropa v. Robie, 187 F.2d 150, 155-59, 88 USPQ 478, 483-87 (CCPA 1951) and the authority cited therein, and cases compiled in 2 Chisum, Patents § 8.06[1][d] (1991). Such statements often, although not necessarily, appear in the claim's preamble. In re Stencel, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

the direction that only the quick connect coupling is being claimed, that is, the brake hose and brake tube are not part of the claimed subject matter. We reach this conclusion based on the appellant's use of the phrases "for crimped connection to the brake hose" and "for connection to the brake tube."

The second clause of claim 1 (i.e., a resilient retaining element extending between the brake tube and connector body) leads us in the direction that the combination of a brake hose, a brake tube and a quick connect coupling is being claimed. We reach this conclusion based on the appellant's use of the term "extending" rather than the phrase "for extending."

The third clause of claim 1 (i.e., a stepped bore in the second end of the body for receiving the brake tube, the stepped bore including a first bore section for communicating with the brake hose, a second bore section for receiving a sealing arrangement that seals between the brake tube and second bore section and a third bore section for receiving the retaining element) leads us in the direction that only the

quick connect coupling is being claimed, that is, the brake hose and brake tube are not part of the claimed subject matter. We reach this conclusion based on the appellant's use of the phrases "for receiving the brake tube" and "for communicating with the brake hose." In addition, it is not clear to us if the "sealing arrangement" is part of the claimed subject matter due to it being recited after the phrase "for receiving."

The last clause of claim 1 (i.e., a groove in the brake tube for abutting another portion of the retaining element to prevent axial movement of the tube from the connector body) leads us in both directions. First, it leads us in the direction that the combination of a brake hose, a brake tube and a quick connect coupling is being claimed. We reach this conclusion based on the appellant's use of a separate clause. Second, it also leads us in the direction that only the quick connect coupling is being claimed, that is, the brake hose and brake tube are not part of the claimed subject matter. We reach this conclusion based on the appellant's use of the phrase "for abutting."

In view of the above conflicting attributes of claim 1, we are unable to determine the scope of claim 1. That is, whether claim 1 is directed to the combination of a brake hose, a brake tube and a quick connect coupling as asserted by the appellant or whether claim 1 is directed only to the quick connect coupling having the intended use of coupling a brake hose to a brake tube. Thus, it is our determination that the appellant has failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112.

#### **NEW GROUND OF REJECTION**

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 1 to 16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention, for the reasons explained above.

In addition, claim 11 lacks proper antecedent basis for "the retaining ring" and "the shoulder." It appears to us that "the retaining ring" is meant to refer back to the resilient retaining element recited in claim 1. Additionally, while claim 1 does recite "a shoulder," it is not "the shoulder" being recited in claim 11. In that regard, the shoulder being recited in claim 1 is either shoulder 40 (Figure 1) or shoulder 112 (Figure 5) while the shoulder being recited in claim 11 is shoulder 114 (Figure 5).<sup>6</sup>

**The rejections under 35 U.S.C. § 103**

Considering now the rejections of claims 1 to 16 under 35 U.S.C. § 103, we have carefully considered the subject matter defined by these claims. However, for reasons stated supra in our new rejection under the second paragraph of Section 112 entered under the provisions of 37 CFR 1.196(b), the scope of the claims under appeal cannot be ascertained. We find that it is not possible to apply the prior art to claims 1 to 16 in deciding the question of obviousness under

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<sup>6</sup> See pages 3-4 of the brief wherein the appellant reads claims 1 and 11 on the drawings.

35 U.S.C. § 103 without resorting to speculation and conjecture as to the scope of claim 1. This being the case, we are therefore constrained to reverse the examiner's rejection of claims 1 to 16 under 35 U.S.C. § 103 in light of the holding in In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). This reversal of the examiner's rejection is based only on the procedural ground relating to the indefiniteness of these claims and therefore is not a reversal based on the merits of the rejection.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 16 under 35 U.S.C. § 103 is reversed and a new rejection of claims 1 to 16 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR §

1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .



No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPEAL NO. 1999-1747 - JUDGE NASE  
APPLICATION NO. 08/715,422

APJ NASE

APJ McQUADE

APJ CALVERT

DECISION: **REVERSED**  
**37 CFR § 1.196(b)**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 04 Oct 99

**FINAL TYPED:**

**Gloria: Note Panel Change**